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| 09/974,529 | 10/09/2001 | William L. Thomas | UV-208 | 9814 |

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| EXAMINER |
|---|
| CHOWDHURY, SUMAIYA A |

| ART UNIT | PAPER NUMBER |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/974,529 | THOMAS ET AL. | |
| | Examiner | Art Unit | |
| | Sumaiya A. Chowdhury | 2623 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *16 April 2007*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-100* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-100* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

## DETAILED ACTION

### *Response to Arguments*

In view of the Appeal Brief filed on 4/16/07, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have been increased since they were previously paid, then appellant must pay the difference between the increased fees and the amount previously paid. "

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing below:

ANDREW Y. KOENIG
PRIMARY PATENT EXAMINER
Acting SPE

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 7-12, 25-30, 32-37, 50-55, 57-62, 75-80, 82-87 and 100, are rejected under 35 U.S.C. 102(e) as being anticipated by Swix (6718551).

As for claims 1, 26, and 76 Swix discloses a method, system, and processor readable medium comprising:

Means (110 - fig.1) for receiving a request for on-demand media (menus – fig. 3) from a user (The user progresses through menu screens (on-demand media) in response to selections made by the user - fig. 3; col. 9, lines 25-28, col. 10, lines 20-67, col. 11, lines 11-23);

Means (110 – fig. 1) for retrieving supplemental content (300 – fig. 3) related to the on-demand media with the interactive television application in response to the request (Based on the user selections, related ads (supplemental content) are displayed. - col. 10, lines 37-67);

Means (110 – fig. 1) for providing the on-demand media in response to the request (col. 10, lines 34-67); and

Means (110 – fig. 1) for providing supplemental content to the user while the user is viewing the on-demand media (The targeted ad is displayed simultaneously with the menu screen. - 302, 304, 306, 308 – fig. 3; col. 10, lines 34-67).

As for claims 2, 27, 52, and 77, Swix discloses wherein the on-demand media is third-party applications (advertisements) – col. 10, lines 37-67.

As for claims 3, 28, 53, and 78, Swix discloses indicating the availability of supplemental content to the user (By displaying the supplemental content, the availability of it is indicated – col. 10, lines 37-67).

As for claims 4, 29, 54, and 79, Swix discloses providing a visual indicator (window 300) of the availability of supplemental content (By displaying the supplemental content, the availability of it is indicated – col. 10, lines 37-67).

As for claims 5, 30, 55, and 80, Swix discloses wherein the visual indicator is selected from the group consisting of video (col. 9, lines 52-55).

As for claims 7, 32, 57, and 82, Swix discloses providing the supplemental content comprises providing supplemental content concurrently with the on-demand media (col. 10, lines 37-67).

As for claims 25, 50, 75, and 100, Swix discloses providing supplemental content to the user in response to receiving a request from the user (As discussed above in claim 1, supplemental content is provided in response to receiving a request from the user for on-demand media).

Claim 51 contains limitations of claim 1 and is analyzed as previously discussed with respect to that claim. Claim 51 additionally calls for the following:

a user input device (mouse; col. 12, lines 1-2);

a display device (2b – Fig. 1);

As for claims 8, 33, 58, and 83, Swix discloses providing supplemental content separately from the on-demand media (col. 12, lines 47-60).

As for claims 9, 34, 59, and 84, Swix discloses retrieving supplemental content prior to viewing the on-demand media (col. 11, lines 35-43).

As for claims 10, 35, 60, and 85, Swix teaches retrieving supplemental content comprises retrieving supplemental content prior to viewing the on-demand media using a carousel approach (col. 9, lines 38-45, col. 13, lines 42-48).

As for claims 11, 36, 61, and 86, Swix discloses retrieving supplemental content comprises storing supplemental content (col. 11, lines 35-57).

As for claims 12, 37, 62, and 87, Swix teaches retrieving supplemental content comprises locally caching the supplemental content associated with the on-demand media (col. 11, lines 35-57).

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 6, 15, 31, 40, 56, 65, 81 and 90, are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix in view Bruner (5594661).

As for claims 6, 31, 56, and 81, Swix fails to disclose:

Detecting when media on a digital storage device is accessed;

Providing the user with the media in response to the detection;

Receiving a request for supplemental content related to the media on the digital storage device;

Retrieving the supplemental content that is related to the media on the digital storage device;

Providing the supplemental content that is related to the media on the digital storage device to the user.

In an analogous art, Bruner teaches:

a) Detecting when media (program related to movies) on a digital storage device (118 – Fig. 1; col. 2, lines 33-36) is accessed (col. 3, lines 21-26);

b) Providing the user with the media in response to the detection (col. 3, lines 21-26);

c) Receiving a request for supplemental content (program related to recent movie releases) related to the media on the digital storage device (col. 3, lines 45-50);

d) Retrieving the supplemental content that is related to the media on the digital storage device (col. 3, lines 45-50);

e) Providing the supplemental content that is related to the media on the digital storage device to the user (col. 3, lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include steps a) – e), as taught by Bruner, for the advantage of allowing the user to select media and supplemental content as desired.

As for claims 15, 40, 65, and 90, Swix discloses providing supplemental content as discussed above but fails to disclose providing an actor interview of an actor.

In an analogous art, Bruner discloses providing an actor interview related to an actor the user is currently watching – col. 4, lines 7-17.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include providing an actor interview of an actor as supplemental content, as taught by Bruner, for the advantage of providing the user with additional content about the actor.

3. Claims 20, 45, 70, and 95, are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix and Kambayashi as applied to claim 18 above, and further in view of Matthews (5815145).

As for claims 20, 45, 70, and 95, Swix fails to disclose wherein the interactive media is an interactive game.

In an analogous art, Matthews discloses wherein the interactive media is an interactive game – col. 9, lines 40-43.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include wherein the interactive media is an interactive game, as taught by Matthews, for the advantage of allowing the user to play a game simultaneously with other users.

4. Claims 13, 22, 23, 38, 47, 48, 63, 72, 73, 88, 97, and 98, are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix in view of Portuesi (5987509).

As for claims 13, 38, 63, and 88, Swix fails to disclose wherein the supplemental content is synchronous metadata.

In an analogous art, Portuesi discloses wherein the embedded URLs (supplemental content) are transmitted along with the movie file – col. 4, lines 30-40, col. 5, lines 43-60.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include wherein the supplemental content is synchronous metadata, as taught by Portuesi, for the advantage of simplifying transmission of a file by transmitting both content in one file.

As for claims 22, 47, 72, and 97, Swix fails to disclose providing links related to the audio portion of the on-demand media.

In an analogous art, Portuesi discloses wherein the URLs are associated with the audio in the movie file – col. 5, lines 60-67.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include wherein the URLs are associated with the audio portion in the movie file, as taught by Portuesi, for the advantage of providing the user with the additional feature of accessing desired audio files by simply clicking on a link.

As for claims 23, 48, 73, and 98, Swix discloses providing supplemental content related to the on-demand media but fails to disclose providing links to content.

In an analogous art, Portuesi discloses that URLs are embedded in images which a user could click on for the advantage of accessing related information – col. 6, lines 3-20.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include providing links to content which the user could click on, as taught by Portuesi, for the advantage of providing the user the convenience of accessing information by simply clicking on a link.

5. Claims 14, 18-19, 24, 39, 43-44, 49, 64, 68-69, 74, 89, 93-94, and 99 is rejected under 35 U.S.C. 103(a) as being unpatentable over Swix as applied to claim 1 above, and further in view of Kambayashi.

As for claims 14, 39, 64, 89, 24, 49, 74, and 99, Swix fails to disclose:

providing the user with at least one option related to supplemental content; and

receiving an indication of the at least one option from the user.

In an analogous art, Kambayashi discloses:

providing the user with at least one option related to supplemental content; and

receiving an indication of the at least one option from the user (The system provides the user the option to select to view the program information of the program. The user then selects whether or not he/she would like to view it – col. 13, lines 50-56, col. 14, lines 45-50).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include the above mentioned limitation, as taught by Kambayashi, for the advantage of making the system interactive for the user.

As for claims 18, 43, 68, and 93, Swix fails to disclose:

providing the supplemental content comprises providing interactive media related to the on-demand media.

In an analogous art, Kambayashi discloses wherein providing the supplemental content comprises providing interactive media (12 – Fig. 28) related to the on-demand media (col. 21, line 49 – col. 22, line 5).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include the above mentioned limitation, as taught by Kambayashi, for the advantage of making the application more user-friendly by allowing the user to interact with the supplemental content.

As for claims 19, 44, 69, and 94, Swix fails to teach:

wherein the interactive media is a survey.

In an analogous art, Kambayashi discloses wherein the interactive media is a survey (col. 21, line 49 – col. 22, line 5).

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include the above mentioned limitation, as taught by Kambayashi, for the advantage of allowing users to voice their opinion/vote.

6. Claims 16-17, 21, 41-42, 46, 66-67, 71, 91-92, and 96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Swix in view of Reimer.

As for claims 16-17, 41-42, 66-67, and 91-92, Swix fails to disclose providing information related to an actor the user is currently watching.

In an analogous art, Reimer discloses wherein the supplemental content provided are actor biographies – col. 11, lines 38-42.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include wherein the supplemental content provided are actor biographies, as taught by Reimer, for the advantage of providing the user with additional information to learn about an actor.

As for claims 21, 46, 71, and 96, Swix fails to disclose providing information related an audio portion of the on-demand media.

In an analogous art, Reimer discloses wherein the user selects to view a scene while listening to voice overs of director or actor with their comments about the scene - col. 5, lines 48-52.

It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to modify Swix's invention to include providing information related an audio portion of the on-demand media, as taught by Reimer, for the advantage of providing the user with supplemental audio content.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumaiya A. Chowdhury whose telephone number is (571) 272-8567. The examiner can normally be reached on Mon-Fri, 9-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Miller can be reached on (571) 272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

SAC

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